

REMARKS

In the Office Communication dated January 4, 2006, claims 1 to 58 were subject to restriction under 35 U.S.C. § 121 as follows:

- I. Claims 1-22, 46 and 47, drawn to compounds and pharmaceutical compositions of the set of compounds described by formulas (I)-(V), classified in class 564 and 514, subclass: various.
- II. Claims 23-45, drawn to methods of use of the above compounds, classified in class 564 and 514, subclass: various.
- III. Claim 48, drawn to an antibody, classified in class 530, subclass: various.
- IV. Claims 49-50, drawn to a method of preparing phenylboronic acid, classified in class 568, subclass: various.
- V. Claims 51-58, drawn to methods of preparing a thyronamine derivative, classified in class 564, subclass: various.

It is stated in the Office Communication that the various groups are directed to unrelated subject matter.

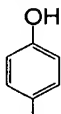
Applicants respectfully traverse the restriction requirement. According to MPEP § 803, there are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 to § 806.05(i)); and
- (B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) to § 806.04(i), § 808.01(a), and § 808.02).

For purposes of the initial requirement, a serious burden may be *prima facie* shown if the examiner shows separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02. In the subject application, the claims have been restricted into 5 different groups, however, these groups have only been classified into three different classes, namely Class 564, Class 568 and Class 530. Applicants respectfully request reconsideration with respect to a reduction in the number of groups from five to two.

Applicants believe that Groups I, II, III, and V which are drawn to compounds and pharmaceutical compositions of the set of compounds, a method of use of the compounds of Group I, a process of making the compounds of Group I, (Groups I, II, and V are all classified in class 564) and an antibody that binds to the compounds of Group I (Group III is classified in Class 530), are so closely related that they should be rejoined into one group. Similarly, Group IV, related to a method for preparing a protected phenylboronic acid should be in one group.

Thus, Applicants respectfully request reconsideration of the requirement for restriction, and in particular an indication that the requirement is only a provisional election for the purpose of carrying out the search. Nonetheless, to be fully responsive to the restriction requirement, Applicants elect *with traverse* to prosecute the claims of Group I (claims 1-22, 46 and 47). Applicants elect *with traverse* to prosecute the species, 3-iodo-2-phenyl-thyronamine, which is a compound of formula I, wherein R₁, R₂, R₃, R₇, and R₈ are H;



R₄ is I; R₆ is OH; X is O; Y is: -CH-; and Z is CH₂. Solely to advance prosecution and without prejudice to pursuing the claims in a continuing application, claims 23-45 and 48-58 are withdrawn.

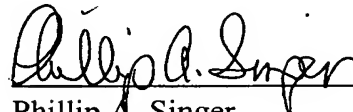
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CONCLUSION

Applicants hereby elect, *with traverse*, Group I consisting of claims 1-22, 46 and 47. Solely to advance prosecution and without prejudice to pursuing the claims in a continuing application, claims 23-45 and 48-58 are withdrawn. Applicants reserve the right to pursue the subject matter of all non-elected claims in one or more related applications. Applicants respectfully request an early and favorable action.

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